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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,769	09/29/2000	Katsuhiko Takahashi	35.C14833	8654

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/672,769

Applicant(s)

TAKAHASHI ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-11.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**Attachment to Advisory Action**

1. Applicants' arguments and 1.132 declaration filed 7/31/02 have been fully considered but they are not persuasive.

Specifically, applicants' argue that the rejections of record are no longer applicable against the present claims in light of the unexpected or surprising results set forth in the 1.132 declaration.

In the rejections of record, either (i) Tsutsumi et al. (U.S. 6,031,019), which teaches the use of urea, was used in combination with Suzuki et al., which teaches the equivalence and interchangeability of urea with ethylene urea or (ii) Suzuki et al. (U.S. 6,153,001) was used in combination with Tsutsumi et al.

In the declaration, ink within the scope of the present claims (Ink A), i.e. comprising ethylene urea, is compared to ink outside the scope of the present claims (Ink B) but within the scope of the closest prior art Tsutsumi et al. and Suzuki et al. i.e. comprising urea. It is agreed that the declaration shows that the ink of the present invention is superior in terms of storage stability, i.e. the ink does not exhibit phase separation.

However, the specification as originally filed does not disclose that ethylene urea affects the phase separation or storage stability of the ink. In fact, there does not appear to be any disclosure of phase separation or storage stability in the present specification. The courts have upheld that a "basic property or utility must be disclosed in order for affidavit evidence of unexpected properties to be offered," *In re Davies et al.*, 177 USPQ 381 (CCPA 1973). The present specification states that the presently claimed ink is superior given that it does not exhibit intermittent ejection defect due to inhibition of increase in viscosity and film formation or

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solidification or exhibits minimal adhesion of thickened ink to ejection port surface. There is no disclosure regarding phase separation or storage stability in the present specification and no disclosure in the 1.132 declaration regarding intermittent ejection defect, viscosity, film formation or solidification, or adhesion of thickened ink to ejection port surface. Thus, applicants' have failed to make a clear and convincing showing of evidence of patentability of the present claims.

Additionally, with respect to the combination of Suzuki et al. with Tsutsumi et al., it is noted that Suzuki et al. teach ink comprising self-dispersing pigment particles which comprise cationic hydrophilic groups but is silent with respect to color-containing resin. Tsutsumi et al. teach an ink jet ink comprising pigment fine particle encapsulated by polymer fine particle. In response to examiner's position that the motivation for using such pigment fine particle encapsulated by polymer fine particle in Suzuki et al. is to produce an ink with improved waterfastness and anti-feathering properties, applicants argue that such effects should not be attributed to just the polymer emulsion but to the ink as a whole. However, col.2, lines 39-43 of Tsutsumi et al. do disclose that in fact it is the incorporation of pigment fine particle encapsulated by polymer fine particle in the ink which results in improved waterfastness and anti-feathering properties. For this reason, it is the examiner's position that there is good motivation to combine Suzuki et al. with Tsutsumi et al.



Callie Shosho

8/12/02

  
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